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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,843	01/17/2002	Yves Van Campenhout	8707.2136	9745
7590	10/19/2004		EXAMINER	NGUYEN, TAI V
ORRICK, HERRINGTON & SUTCLIFFE LLP 666 Fifth Avenue New York, NY 10103-0001			ART UNIT	PAPER NUMBER
			3729	

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

S6

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/056,843	CAMPENHOUT ET AL.	
	Examiner Tai Van Nguyen	Art Unit 3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 17 January 2002.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-6 is/are pending in the application.  
 4a) Of the above claim(s) 4-6 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-3 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date 04/01/02, 01/17/02.

4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-3, drawn to a method of manufacturing a plurality of hybrid electronic circuit, classified in class 29, subclass 832.
  - II. Claims 4-6, drawn to an active implantable medical device electronic circuit, classified in class 174, subclass 250.
2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product Group II, can be made by a materially different process, such as on without any supporting.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Robert M. Isackson on 10/14/2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-3. Affirmation of this election must be made by applicant in replying to this Office action. Claims 4-6 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Objections***

5. Claim 1 objected to because of the following informalities:

In claim 1, the term "like" (line 5) should be change to – the -- . Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3 are rejected under 103(a) as being unpatentable over Noyori et al in view of Gustafson (US 5,879,502).

As applied to claims 1 and 3, Noyori et al disclose a method of manufacturing a plurality of hybrid electronic circuits for active implantable medical devices, comprising: a) providing a flat collective plate-substrate (16, Fig. 9) comprising, on a first surface (50), a plurality of repeating patterns of a contact area for connection to at least one chip (19), and a second surface (52) opposite the first surface having a plurality of repeating patterns of a metallization area for receiving at least one of an active SMC component (19), a passive SMC component, and a connector element, wherein the collective plate-substrate pluralities of contact areas (20) and metallization areas correspond to a plurality of implantable device electronic circuits, gluing (read as connected through the

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openings 51 on the insulation layer 50, column 9, lines 30-38) on the first surface (50) of the collective plate-substrate a second (52) plurality of chips, wherein each of the implantable device electric circuits has at least one b) corresponding chip, cabling each of the glued chips to an associated contact area each individual substrate corresponding to an individual implantable device electric circuit (column 10, lines 39-48); and g) mounting at least one SMC component and/or a connector element (51) to the second surface (52) of each individual substrate, to form the plurality of electric circuits of the implantable devices (see Fig. 9).

However, Noyori et al do not teach d) pouring a coating resin over the first surface of the plate-substrate, e) hardening the coating resin and f) cutting the collective plate-substrate into a plurality of individual substrates, each substrate having on its first surface at least one glued chip coated by the resin, each individual substrate corresponding to an individual implantable device circuit. Gustafson teaches a manufacturing process that includes: d) pouring a coating resin over the first surface of the plate-substrate (column 4, lines 34-60+), e) hardening the coating resin (column 7, lines 29-43) and f) and cutting the collective plate-substrate into a plurality of individual substrates, each substrate having on its first surface at least one glued chip coated by the resin, each individual substrate corresponding to an individual implantable device circuit (column 7, lines 45-61). It would have been an obvious to one of ordinary skill in the art at this time the invention was made to have modified Noyori et al method by including the manufacturing process of Gustafson, to positively improve the tightness of the body and increase its rigidity (column 5, lines 32-33).

As applied to claim 2, Noyori et al further discloses d) spreading the resin over the peripheral area by gravity, and wherein stage f) cutting off the peripheral marginal area (column 10, lines 39-48).

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tai Van Nguyen whose telephone number is 703-308-1791. The examiner can normally be reached on M-F (7:30 A.M - 4:30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TN.

October 6, 2004



A. DEXTER TUGBANG  
PRIMARY EXAMINER